

## REMARKS

The issues outstanding in this application are as follows.

- The Information Disclosure Statement filed August 14, 2002 is deemed non-compliant.
- The listing of references provided in Applicant's specification has not been considered.
- The drawings are objected to under 37 C.F.R. 1.83(a).
- Claims 1-10 are rejected under 35 U.S.C. § 112.
- Claims 1-5 and 8-10 are rejected under 35 U.S.C. § 102.
- Claims 1-10 are rejected under 35 U.S.C. § 103.

Claims 3 and 9 are canceled without prejudice, claims 1-2, 4-8, and 10 are currently amended, and new claims 11-20 have been added. Claims 1-2, 4-8, and 10-20 are pending in this application. Based on the following, Applicant contends that all pending claims are allowable, and reconsideration of the pending claims is respectfully requested. No new matter has been added.

### Information Disclosure Statement:

In the Information Disclosure Statement (IDS) accompanying this response, Applicant has again listed the references that were included in the August 14, 2002 IDS that was deemed non-responsive in the Office Action for failure to provide legible copies. Legible copies are now provided in the attached re-submission. Moreover, the newly submitted IDS additionally lists and submits references associated with a selection of the games discussed in the background section of Applicant's specification. Applicant is not able to identify issued patents associated with all of the games discussed in the specification. However, all the references pertinent to the listed games, that are known to Applicant, are listed in the newly submitted IDS. Accordingly, Applicant contends that the current IDS fully complies with 37 CFR §§ 1.56, 1.98, and 1.99.

Applicant notes that where applicable, it is proper to discuss the problems involved in the prior art which are solved by the applicant's invention. See M.P.E.P. § 608.01(c). Accordingly, Applicant asserts that the discussion of prior art games in the background section of Applicant's specification is proper.

**Amendments to the Title:**

The title has been amended to more clearly reflect the subject matter of the present invention. No new matter has been added.

**Amendments to the Specification:**

The “brief description of the drawings” has been amended to add descriptions of the new drawings requested by the Office Action.

Paragraph [0042] has been amended to refer to newly added Figure 6 and includes reference numerals for various apparatus components shown in Figure 6. Figure 6 is based on originally presented claim 10. Aside from adding reference numerals, the paragraph has been amended for clarity.

Newly added paragraph [0042.1] includes narrative text corresponding to claim 1 and includes reference numerals corresponding to those used in newly added Figure 7 which illustrates claim 1. Newly added paragraph [0042.2] includes narrative text corresponding to claim 2 and includes reference numerals corresponding to those used in newly added Figure 8 which illustrates claim 2. Newly added paragraph [0042.3] includes narrative text corresponding to claim 11 and includes reference numerals corresponding to those used in Figure 9 which illustrates claim 11. Newly added paragraph [0042.4] includes narrative text corresponding to claim 16 and includes reference numerals corresponding to those used in Figure 10 which illustrates claim 16. Support for these newly added paragraphs is found in the same places in the specification as the support for the claims corresponding to the respective paragraphs, which claim support is discussed below in the section entitled “changes to the claims.” To avoid needless repetition, the discussion of support is provided only in the “changes to the claims” section below.

No new matter has been added in the above amendments.

**Objections to the Drawings:**

The drawings are objected to under 37 C.F.R. § 1.83(a). Additional drawings are provided with this response illustrating the steps of the original and new method claims and the apparatus of claim 10, as amended. Support for the changes to the drawings is

discussed in the following section. No new matter has been added. Formal drawings are now submitted for all figures.

**Changes to the Drawings:**

In the following, the page, paragraph, and line numbers refer to the application as originally filed. No new matter has been added.

Figure 6 has been added to show the casino slot machine recited in original claim 10. Claim paragraph (a) of original claim 10 is shown as "paytable display" 602 in Figure 6. The "processor" of original claim paragraph (b) of claim 10 is shown as block 614 in Figure 6. The "matrix" referred to in original claim paragraph (b) is shown as block 604, in a second display 612. The recited "rows" are designated by reference numeral 606, and the recited "columns" are designated by reference numeral 608 and are supported, for example, by Figure 1. The symbols in the rows 606 and columns 608 are designated by reference numeral 610. The second display 612 also serves as a touch screen player input means as supported at paragraph [0030].

Figure 7 has been added to illustrate the method steps of amended claim 1. Figure 1 is supported by claim 1 as originally filed. The play 700 of the slot machine occurs in block 702. Method step 704 of displaying a matrix of symbols as a spin outcome is also supported in paragraphs [0019], [0024], [0028] and [0030]. Method step 706 of selecting by a player is also supported in paragraphs [0030] and [0038]. Method step 708 of converting is also supported in paragraph [0038]. Method step 710 of awarding is also supported at paragraph [0038].

Claim 2 is illustrated in Figure 8 as supported by original claim 2. The play 80 of the slot machine occurs in block 802. The "depicting" method step of claim 2 is illustrated in method step 804 which is also supported in paragraph [0036]. The "allowing" method step of claim 2 is illustrated at 806. The "displaying a matrix" method step 808 is further supported in paragraphs [0019], [0030], and [0038]. The "selecting" method step 810 is further supported in paragraphs [0030] and [0038]. The "converting" method step 812 is further supported in paragraph [0030]. The "awarding" method step 814 is further supported at paragraph [0038]. The dependent claims 4-8 are further details of the illustrated method steps in Figure 8 and do not need to be illustrated.

Claim 11 is illustrated in Figure 9. Play 902 of the casino game comprises the following method steps 900. The “wagering” method step 904 of claim 11 is supported in paragraph [0013]. The “presenting” method step 906 is supported in paragraphs [0030] and [0038]. The “randomly including” method step 907 is supported in paragraphs [0019], [0030], and [0038]. The “qualifying” method step 908 is supported in paragraph [0038]. The “selecting” method step 909 is supported in paragraphs [0030] and [0038]. The “converting” methods step 910 is supported in original claims 1-3 and in paragraphs [0030] and [0038]. The “providing a payoff” method step 912 is supported at paragraph [0038]. The dependent claims 12-14 are further details and do not need to be illustrated.

Claim 16 is illustrated in Figure 10. Play 1002 of the casino game comprises the following method steps 1000. The “presenting” step 1004 is supported in paragraph [0013]. The “randomly qualifying” step 1006 is supported in paragraphs [0019], [0030], and [0038]. The “selecting” step 1008 is supported in paragraphs [0030] and [0038]. The “converting . . . wild” step 1010 is supported in original claims 1-3 and in paragraphs [0030] and [0038]. The “providing a payoff” step 1012 is supported on paragraph [0038]. The dependent claims 17-20 are further details and do not need to be illustrated.

#### **Changes to the Claims:**

New claims 11-15 have been added to more clearly define the present invention. Claims 1-10 have been amended for this same reason and to respond to the 35 U.S.C. § 112 rejections presented in the Office Action. Amendments to the previously entered claims and the new claims are supported by Applicant’s originally filed application as described below. In this section, the page, paragraph, and line numbers refer to the originally filed specification.

The changes to claims 1 and 2 are supported in paragraph [0019] and on pages 7-8. Claim 4 is supported on page 9, fourth paragraph, and in claim 4 as originally filed. Claims 5 and 6 are supported by the original version of each respective claim and on page 10, first paragraph. Claim 7 is supported by its originally filed version. Claim 8 is supported by its original version. Claim 10 is supported by its originally filed version, on page 7, first paragraph, on page 3, second paragraph, in paragraph [0019], and on page 8, last paragraph. Claim 11 is supported on page 3, last paragraph, in paragraph [0019], and on

pages 7-9. Claim 12 is supported on page 8, last paragraph. Claims 13-15 are supported on page 8, first paragraph (after the table). Claim 16 is supported in paragraph [0019] and on pages 7-9. Claim 17 is supported in paragraphs [0030] and [0038]. Claim 18 is supported in paragraph [0038]. Claim 19 is supported in paragraph [0038]. Claim 20 is supported in paragraph [0036].

**Rejection Under 35 U.S.C. § 112, Second Paragraph:**

Claims 1-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 3 and 9 have been canceled, and the rejection thereof is therefore considered moot. Claims 1-2, 4-8, and 10 have been amended both to more clearly define the claimed invention and to respond to the 35 U.S.C. § 112, second paragraph, rejections in the Office Action. Applicant asserts that claims 1-2, 4-8, and 9-10, as amended, are definite under 35 U.S.C. § 112, second paragraph.

**Rejection Under 35 U.S.C. § 102(e):**

Claims 1-5 and 8-10 are rejected under 35 U.S.C. § 102(e) as being anticipated by Singer et al. (U.S. Patent No. 6,604,740 hereafter Singer). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant respectfully asserts that Singer does not teach or suggest all the limitations of Applicant's amended claims. Claims 3 and 9 have been canceled without prejudice, and the rejection thereof is therefore considered moot.

Independent claim 1, as amended, recites "selecting, by a player, at least one of said displayed symbols only when at least one trigger symbol randomly appears in said spin outcome." Under the teachings of the present invention as set forth in the specification, the player is accorded the opportunity to select one of the displayed symbols to become a wild symbol and only when a trigger symbol appears in the spin outcome. As claimed, there are two important method differences not found in Singer. In the claimed invention, the player selects after the spin outcome of symbols is displayed and only when a trigger symbol is also displayed in the spin outcome. Thus, Applicant's "selecting" is performed after the display of

symbols is established. In contrast, in Singer, the player selects a wild symbol before the reels are spun. See Singer, col. 12, lines 62-66. Thus, in Singer, the player's wild symbol selection could not have been a "displayed symbol". Singer therefore does not teach, suggest, or infer all the limitations of independent claims 1, 2, and 10. Claims 1, 2, and 10 are therefore patentable over Singer.

The Office Action asserts that the player "may incorporate strategy by being able to select one symbol as a wild symbol" and cites col. 10, lines 15-20 of Singer as support. Applicant respectfully disagrees. Selecting an optimum wild symbol depends on the spin outcome and information in the pay table. Applicant's specification discusses such strategic selection in detail on page 9, third paragraph, with reference to Figure 4. In Singer, since the player selects the wild symbol before the reels are spun, the information needed to identify an optimum wild symbol is not yet available to the player. Furthermore, in Singer, the player selects a wild symbol by pushing one of three separate spin buttons before spinning. See col. 12, lines 28-31. Thus, the type of strategic selection disclosed in Applicant's specification is not available when selecting a wild symbol first and spinning the reels afterward (as recited in col. 10, line 15 of Singer). Singer is purely a random game outcome with no strategy by the player.

Claims 4-8 depend from claim 2, inherit all its limitations, and are therefore patentable over Singer for the same reasons as claim 2. Moreover, the dependent claims recite further novel, nonobvious limitations not taught or suggested in the prior art. Limitations in a selection of the dependent claims are discussed below.

Claim 4 recites converting to wild all instances of the at least one symbol. The Office Action asserts that Figure 9b of Singer teaches this limitation. In col. 11, Singer recites: "In general, line-scatter pays involve two or more of the same line-scatter pay symbols that appear anywhere on an active pay line". In this section, Singer does not disclose that all instances of a particular symbol have been made wild in Figure 9b. Moreover, a comparison of Figure 9b to figures preceding and succeeding Figure 9b does not indicate the universal conversion of instances of any particular symbol into wild symbols. Accordingly, Applicant respectfully asserts that the cited portion of Singer does not teach or suggest the limitations of claim 4. Claim 4 therefore adds patentable features to those it inherits from claim 2 from which it depends.

Claim 7 recites converting to a wild symbol each of the remaining symbols in a line in said matrix having the one selected symbol. The specification specifically teaches a row or a column (i.e., lines). There is no teaching in Singer and this claim when read with independent claim 2 is patentable over Singer.

Claim 8 recites depicting a pay table and applying strategy in selecting the symbols based on the spin outcome and information in the pay table. The Office Action suggests that Singer enables a player to apply strategy based on information in the pay table of Singer. Applicant has already shown above that the strategy explained in detail in Applicant's specification cannot be practiced in the game of Singer because the wild symbol selection in Singer occurs before the reels are spun. In Applicant's invention, the pay table information aids the player to optimally select a wild symbol based on the best pay out available among the already-displayed symbols in the spin outcome. Strategy is not disclosed in Singer and is precluded in Singer's system. Claim 8 therefore adds patentable features to those it inherits from claim 2 from which it depends.

With respect to claim 10, the Office Action asserts that the apparatus recited in claim 10 is "inherent" to the method disclosed in Singer. A rejection based on inherency indicates that certain descriptive matter is not explicitly disclosed in the pertinent reference. Accordingly, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " M.P.E.P. § 2112, quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Office Action has not identified the descriptive matter missing from Singer or why such matter must necessarily be present in Singer. Accordingly, Applicant contends that the Office Action inherency rejection does not satisfy the requirements in the above-quoted rule recited in M.P.E.P. § 2112. If this rejection is maintained, Applicant respectfully requests that the Examiner specifically identify the matter lacking explicit disclosure in Singer and the basis for it being necessarily included therein so that Applicant may have a full and fair opportunity to respond.

In view of the foregoing, Claims 1-2, 4-5, 8, and 10 are patentable over Singer under 35 U.S.C. § 102.

**Rejection Under 35 U.S.C. § 103(a):**

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Singer. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criterion, Applicant contends that the first and third criteria for the *prima facie* case of obviousness are not satisfied for the rejection of claim 6.

Applicant has already shown that claim 2 defines limitations not taught or suggested by Singer. Claim 6 depends from claim 2 and therefore inherits limitations from claim 2 already shown not to be taught or suggested by Singer. Moreover, as shown in the following, claim 6 recites further features not taught or suggested by Singer in addition to those it inherits from claim 2.

The Office Action concedes that Singer does not disclose the manner in which the multiplier is determined. See Office Action, page 7, last paragraph. However, the Office Action attempts to cure this deficiency in the prior art by asserting that the feature of randomly choosing the multiplier is "well known in the art."

The Applicant agrees that the use of "multipliers" is well known in the gaming industry. However, the use of randomly applying multipliers in the context of claim 2 is not taught in Singer nor rendered obvious thereby. Hence, claim 6 when read with claim 2 is patentable over Singer and not obvious.

**Rejection under 35 U.S.C. § 103(a):**

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Singer in view of Bennett (U.S. Patent No. 6,089,977). Without conceding the second criterion, Applicant asserts that the first and third criteria of the *prima facie* case of obviousness under M.P.E.P. § 2143 (quoted above) are not satisfied.

Parent claim 2 recites having the player select at least one symbol in the spin outcome displayed and then converting the selected at least one symbol to be a wild symbol. Singer

does not teach or suggest this limitation, and in fact precludes practicing this limitation, since in Singer, the player selects the wild symbol before the reels are spun. The discussion concerning Singer above is incorporated herein by reference.

Bennett does not cure this deficiency. Bennett does not convert a player-selected symbol into a wild symbol. Bennett teaches first the appearance of a special symbol or combination of symbols and second a roaming wild symbol moving along a pre-determined path. Specifically, the wild symbol "is displayed in a first display location and then progressively moved to each of a predetermined number of other display locations, a prize being awarded for winning combinations formed with the wild card symbol for each location in which the wild card symbol is displayed." See col. 2, lines 2-6.

There is player selection in Bennett whatsoever. Rather, the special feature of Bennett is invoked only when the special symbol or combination of symbols occurs (Abstract). Then, when it occurs in Bennett, the wild symbol moves along a predetermined path. In claim 7 when read with claim 2, the player selects the symbol that is displayed to become wild and then a line of symbols including that symbol is converted to a wild. This is all under player control and the player strategically makes this decision based upon the displayed outcome and the pay table to optimize the player's award. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." See M.P.E.P. § 2144.04(C) citing *Ex Parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984) (emphasis added). In this case, the asserted motivation to modify Singer to include the features of claim 7 has clearly not been drawn from either Singer or Bennett. The motivation therefore appears to have been drawn from Applicant's specification. Accordingly, the assertion of motivation based on "design choice" is improper under the above-quoted rule. If this rejection is maintained on the basis that the prior art provides the pertinent motivation, Applicant respectfully requests that a teaching reference (or references) be provided to show both a) the teaching or suggestion of the feature of making an entire line of symbols wild based on a user-selected symbol (since this limitation is not taught or suggested by the art applied in the Office Action) and b) the motivation to modify Singer to incorporate this feature.

In view of the foregoing, the first criterion of the *prima facie* case of obviousness for the rejection of claim 7 when read with claim 2 is not satisfied. Since the first and third

criteria of the *prima facie* case of obviousness under M.P.E.P. § 2143 are not satisfied, claim 7 is patentable over Singer in view of Bennett under 35 U.S.C. § 103(a).

**Rejection under 35 U.S.C. § 103(a):**

Claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams (U.S. Patent No. 5,431,408 hereafter Adams). Claims 3 and 9 have been canceled without prejudice and the rejection thereof is therefore considered moot.

Claim 1 defines the limitations of “displaying a matrix of symbols as a spin outcome . . . ; “selecting . . . at least one of the displayed symbols, only when at least one trigger symbol randomly appears in said spin outcome”; and converting said at least one symbol to be a wild symbol”. Claims 2 and 10 define similar limitations. Adams does not teach or suggest these limitations.

Adams is directed to a card game that provides a wild card in one game which the player may reserve for use in a later game if desired. Adams’ card game provides two separate play situations. In the first situation, the game provides a wild card to the player, which may be either used or reserved. In a second situation, the player is dealt a hand and may optionally use a previously reserved wild card to improve the payout of the dealt hand.

The first type of situation in Adams is particularly far removed from Applicant’s claimed invention since no card is converted into a wild symbol. Instead, the player may choose to reserve a card that was already wild and for which conversion into a wild card is inapplicable. See col. 3, fourth paragraph. Thus, this first card-hand situation of Adams does not teach or suggest the limitations of claims 1, 2, or 10.

In the second card-hand situation of Adams, a player is dealt cards and may optionally employ a previously reserved wild card to make one of the dealt cards wild, thereby providing a better resulting hand and a better payout. See col. 3, second paragraph. However, Adams is silent with respect to Applicant’s claim 1 limitations of “at least one trigger symbol randomly appearing” and “selecting . . . only when the at least one trigger symbol randomly appears”.

Adams only teaches displaying two types of symbols to the player: ordinary cards and wild cards. There is no teaching or suggestion of displaying a trigger symbol. Moreover, once a wild card has been reserved in Adams, no condition of any kind occurring in a spin outcome, or otherwise, is needed for the Adams player to select a card for conversion into a

wild card. Accordingly, Adams does not teach or suggest all the limitations of independent claims 1, 2, and 10.

Claims 4-8 depend from claim 2, inherit all its limitations, and are therefore patentable over Adams for the same reasons as claim 2. Moreover, claims 4-8 recite further novel, nonobvious features not taught or suggested in the prior art. Therefore, claims 1-2, 4-8, and 10 are patentable over Adams. A selection of the additional patentable features in claims 4-8 is discussed below.

The Office Action asserts that Applicant has admitted that the limitations of claim 4 are taught by the prior art. Applicant respectfully refutes this assertion. Applicant's specification, on page 2, lines 7-14 discusses an existing game that makes all symbols on a reel wild in succession and another existing game that makes all the symbols in any position on any reel wild in succession. Since claim 4 (by inheritance from claim 1) recites "awarding the player in accord with a pay table . . ." for "said spin outcome" (emphasis added), it follows that the instances of the symbol undergoing conversion to wild all do so within a single game rather than "in succession." Accordingly, the recited features of claim 4 are not admitted to be prior art in Applicant's specification. Moreover, Adams does not teach or suggest the limitations of claim 4. Accordingly, claim 4 adds further patentable features to those it inherits from claim 2 from which it depends.

Claim 6 recites the limitation "randomly choosing said enhanced multiplier" (to be employed for said awarding). Adams does not teach or suggest this limitation. However, the Office Action asserts that the limitations of claim 6 are notoriously well known in the art. As previously stated in response to the rejection of claim 6 over Singer under 35 U.S.C. § 103(a), the features of claim 6 are not capable of "such instant and unquestionable demonstration as to defy dispute" as required by the rule stated in M.P.E.P. § 2143.03. Because the issue of "knowledge in the art" of the limitations of claim 6 is discussed at length previously in this document, the remarks in the prior discussion are not repeated here. However, in brief, Applicant respectfully requests that a teaching reference be provided to demonstrate knowledge in the art of the recited features of claim 6.

Claim 7 defines the limitation "converting to wild all symbols in the same line of said matrix as said selected at least one symbol." Adams does not teach or suggest this limitation. Adams only teaches (and only illustrates) the availability of a single wild card for

conversion of a fixed card or symbol to a wild card. Moreover, although the rejection over Adams rejects claims 1-10, the Office Action does not mention claim 7 in the rejection remarks or even allege that any particular section of Adams teaches or suggests the limitations of claim 7. Accordingly, claim 7 adds further patentable features to those it inherits from claim 2 from which it depends. In view of the foregoing, Applicant asserts that claims 1-2, 4-8, and 10 are patentable over Adams under 35 U.S.C. § 103(a).

**Patentability of the New Claims:**

New claims 11-20 are added to more clearly state the claimed invention. The limitations discussed above are incorporated herein and for the reasons discussed above, all of which are incorporated by reference herein, each of these claims are patentably distinct over the cited art.

**Amendments to the Abstract:**

The abstract has been amended to more clearly reflect the subject matter of the present application and to respond to the objection in the Office Action. No new matter has been added.

**Conclusion:**

Based on the foregoing, all pending claims are allowable, and Applicant respectfully requests that the instant case be passed to issue. Should you have any questions regarding the above, please feel free to give the below-listed attorney a call. If additional fees are required, please debit our Deposit Account No. 04-1414.

Respectfully submitted,

DORR, CARSON, SLOAN, BIRNEY & KRAMER, P.C.

Date: 1/26/04 By: Robert C. Dorr

Robert C. Dorr  
Reg. No. 27,782  
3010 East 6th Avenue  
Denver, Colorado 80206  
(303) 333-3010

C:\Docs\Patent\Mikohn\357 - Response to 08-26-2003 OA